



AF/8/3621

JAN 27 2003

## TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.  
END919990079US1

Applicant Of: R. F. Gloor et al

Serial No.	Filing Date	Examiner	Group Art Unit
09/439,310	11/12/1999	James A. Reagan	3621

Invention: BUSINESS METHOD FOR QUALITY ASSURANCE OF SERVICES

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on  
11/19/2002

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Dated: 21 JAN 2003

William E. Schiesser P-53,559  
IBM Corporation Dept. N50/Bldg. 40-4  
1701 North Street  
Endicott, NY 13760

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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JAN 29 2003

GROUP 3600

In Re Patent Application of:

Applicant: R. F. Gloor et al. : IBM Corporation  
Serial No.: 09/439,310 : Intellectual Property Law  
Filed: 11/12/1999 : Department N50E/040-4  
: 1701 North Street  
Group Art Unit: 3621 : Endicott, New York 13760  
Examiner: James A. Reagan

Title: Business Method for Quality Assurance of Services

Docket No.: EN999079

Assistant Commissioner  
for Patents  
Washington, DC 20231

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*Georgia Y. Brundege* 1-21-03  
Georgia Y. Brundege Date

APPELLANTS' BRIEF PURSUANT TO 37 C.F.R. 1.192(c)

Sir:

This appeal brief, pursuant to the Notice of Appeal dated 11/19/2002, is an appeal from the Final Office Action dated 07/15/2002, and the Advisory Action dated 10/09/2002 in which Examiner James A. Reagan finally rejected Claims 1, 2, and 4 in the above-identified application. This appeal brief is being filed in triplicate pursuant to 37 C.F.R. 1.192(a).

EN999079

-1-

S/N 09/439,310

### **REAL PARTY IN INTEREST**

The real party in interest in this appeal is International Business Machines Corporation of Armonk, NY, assignee of the entire interest in the above-identified application.

### **RELATED APPEALS AND INTERFERENCES**

The Appellants, their legal representatives, and the assignee are not currently aware of any appeal that may directly affect, or be indirectly affected by, or have some bearing on the Board's decision in this appeal.

### **STATUS OF CLAIMS**

Claims 1-9 were filed in the original application. Claims 1, 2, and 4 are currently pending. Claims 5-9 were subject to a restriction requirement during prosecution of the application, and are now cancelled from the application without prejudice. Claim 3 was cancelled from the application without prejudice, and the step thereof incorporated in Claim 1.

Claims 1, 2, and 4 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by Eisner, "Essentials of Project and Systems Engineering Management" (hereinafter referred to as "Eisner"). Claim 4 also stands finally rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, and under 35 U.S.C. 112 as being indefinite for failing to point out and distinctly claim the subject matter which the applicant regards as the invention.

The rejections of Claims 1, 2, and 4 cited hereinabove are now the subject of the present appeal. The claims at issue are attached in the appendix.

#### **STATUS OF AMENDMENTS**

An amendment under 37 C.F.R. 1.116 was filed on 09/16/2002, and the Advisory Action dated 10/09/2002 indicated that this amendment will be entered for purposes of Appeal.

#### **SUMMARY OF INVENTION**

The present invention discloses a quality assurance method for formulating, proposing, and delivering service solutions in a high quality manner. All page and line references cited hereinbelow from Appellant's application refer to the double spaced new application papers requested by the Examiner in the First Office Action dated 02/26/2002, and filed on 05/21/2002.

According to the present invention, a service provider which has a business objective defines a first solution for a customer which has a need (see Appellant's Best Mode for Carrying Out the Invention, page 7, lines 5-13), a first assurance review of the first solution is performed to determine whether the first solution is technically viable, deliverable, and includes technical risk identification, assessment, and containment plans (see Appellant's Best Mode for Carrying Out the Invention, page 8, lines 5-25). A second assurance review of the first solution is performed to determine whether the first solution includes complete schedules, a complete cost and profit case, and whether

the first solution satisfies both the provider business objectives and the customer need (see Appellant's Best Mode for Carrying Out the Invention, page 9, lines 5-15). A second solution is defined by the provider, by correcting any deficiencies identified in the first or second assurance reviews (see Appellant's Best Mode for Carrying Out the Invention, page 9, lines 17-21), and customer commitment is obtained to the second solution (see Appellant's Best Mode for Carrying Out the Invention, page 10, lines 14-18). An optional third assurance review of the second solution may be performed to determine whether the deficiencies have been satisfactorily corrected (see Appellant's Best Mode for Carrying Out the Invention, page 10, lines 5-12). Thereafter, a first readiness review of the second solution is performed to identify new issues or risks which arose while obtaining customer commitment, determine whether delivery plans are established, and establish baselines for performance and the profit case. The first readiness review is performed by conducting a meeting to examine whether written delivery plans comprising communication delivery plans, organization delivery plans, tracking delivery plans, change control delivery plans, quality management delivery plans, and reporting delivery plans are all established (see Appellant's Best Mode for Carrying Out the Invention, page 11, lines 5-15). A project management review is periodically performed to verify that the second solution is being managed as defined, meeting the profit case, and meeting the customer need (see Appellant's Best Mode for Carrying Out the Invention, page 11, lines 17-22). Thereafter, a deliverable readiness review is performed to verify that the second solution has been delivered to the customer and that the second solution satisfies the customer need (see Appellant's Best Mode for Carrying Out the Invention, page 12, lines 5-11).

## ISSUES

There are three (3) issues, as follows:

**Issue 1:** Claims 1, 2, and 4 have been finally rejected under 35 U.S.C. 102(b) as being anticipated by Eisner. The issue is whether Claims 1, 2, and 4 are anticipated by Eisner.

**Issue 2:** Claim 4 has been finally rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The issue is whether Claim 4 is directed to non-statutory subject matter.

**Issue 3:** Claim 4 has been finally rejected under 35 U.S.C. 112 as being indefinite for failing to point out and distinctly claim the subject matter which the applicant regards as the invention. The issue is whether Claim 4 is indefinite.

## GROUPING OF CLAIMS

The rejected claims stand or fall together.

## ARGUMENT

### Issue 1

Claims 1, 2, and 4 are not anticipated by Eisner  
under 35 U.S.C. 102(b)

Appellants maintain that Eisner does not describe all of the

steps and the particular combination found in Claims 1, 2, and 4.

Specifically, the pages of Eisner cited by the Examiner do not describe Appellants' Claim 1 step of performing a first assurance reviewed by determination of technical viability of said first solution nor describe determination of deliverability of said first solution.

Eisner pages 46-53, 157, and 160-161 describe requirements definition, confirmation that needs, goals, and objectives are still current, and analysis of alternatives to select a preferred system architecture. While these activities may support defining a first solution step, none of these describe all of the requirements noted above in Appellants' step of performing a first assurance review, such as determining whether said first solution is technically viable, deliverable, and includes technical risk identification, assessment, and containment plans.

Claim 1 also requires performing a second assurance review having four (4) business items. Although the Examiner points to Eisner's description of Life-Cycle Costing and budgeting and scheduling constraints, Eisner does not describe all four (4) requirements of Appellants' second assurance review. These are specifically whether said first solution includes complete schedules, a complete cost and profit case, whether said first solution satisfies both said provider business objectives and said customer need. Eisner therefore does not describe Appellants' step of performing a second assurance review.

Claim 1 also requires performing a first readiness review of said second solution to ... establish baselines for performance and profit. A baseline is defined on Appellants' Best Mode for

Carrying Out the Invention, page 11, lines 14-15 as a measure of the expected level based on the second solution plans.

The Examiner points out that Eisner's Figure 7.3, page 155, in box 9 has "Recompose and refine baseline concept". While the word baseline appears in box 9, this step describes a baseline concept, which is not Appellants' baselines for performance and profit as required by Claim 1 in light of Appellants' Best Mode for Carrying Out the Invention. Eisner therefore does not describe each and every element of Appellants' claimed readiness review step.

Inasmuch as Eisner does not describe Appellants' steps of performing a first assurance review, nor performing a second assurance review, nor performing a first readiness review, all of the steps or elements required by Appellants' claims are not disclosed in a single reference as is required in a 35 U.S.C. 102(b) rejection pursuant to MPEP 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Accordingly, it is respectfully requested that the rejection of Claim 1 under 35 U.S.C. 102(b) be reversed, as Claim 1 is allowable based on the arguments presented hereinabove.

Claims 2 and 4 depend directly on allowable Claim 1 and are therefore also allowable, and it is respectfully requested that the rejection of Claims 2 and 4 under 35 U.S.C. 102(b) also be reversed.



## Issue 2

**Claim 4 is not directed to non-statutory subject matter under 35 U.S.C. 101.**

Claim 4 stands rejected under 35 U.S.C. 101 as directed to non-statutory subject matter. Appellants respectfully disagree and proffer the following argument.

Dependent claim 4 limits a step of independent Claim 1. Specifically, the Claim 1 step of performing a first readiness review to identify new issues or risks which arose during the obtaining customer commitment step, determine whether delivery plans are established, and establish baselines for performance and the profit case, is limited by Claim 4. To wit, the determining whether delivery plans are established clause of Claim 1 is further limited by the examining whether written delivery plans comprising communication delivery plans, organization delivery plans, tracking delivery plans, change control delivery plans, quality management delivery plans, and reporting delivery plans are all established limitations of Claim 4.

Claims 1 and 4 are method claims to a business process, which is clearly statutory and allowable subject matter. The step of claim 1 as further limited by Claim 4 is clear and definite. A meeting is conducted to examine whether written delivery plans are all established. The result of this examination is then used in the next step of Claim 1, specifically, periodically performing a project management

review. As stated in Appellants' Best Mode for Carrying Out the Invention, page 11, lines 20-22, the frequency of performing the project management review step may depend on the results of the first readiness review step which is the step limited by Claim 4.

In his Final Rejection (Paper No. 4), the Examiner asserts that Claim 4 "merely relates a thought process and not a physical device". However, this is neither a relevant, nor a cogent assertion inasmuch as Claim 4 is not directed to a physical device, but rather is a method claim as explained hereinabove.

The steps are clear and one could repeat the examination to determine whether all written delivery plans are established and then use the results of the examination in setting the frequency of the project management reviews of Claim 1.

Accordingly, it is respectfully requested that the rejection of Claim 4 under 35 U.S.C. 101 be reversed, as Claim 4 is allowable based on the arguments presented hereinabove.

### **Issue 3**

**Claim 4 is not indefinite under 35 U.S.C. 112.**

Claim 4 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner asserts that Claim 4 does not recite what one would expect to gain from the examination, and is therefore vague and indefinite. However, Claim 4 is dependent on Claim 1 and includes all of the steps of Claim 1. In particular, Claim 4 includes limitations as to the performing of a readiness review. As noted hereinabove, the

frequency of the project management reviews of Claim 1 may depend on the results of the readiness review examinations performed in Claim 4. Claim 4 therefore is definite.

Accordingly, it is respectfully requested that the rejection of Claim 4 under 35 U.S.C. 112 be reversed, as Claim 4 is allowable based on the arguments presented hereinabove.

### CONCLUSION

In summary, Eisner does not teach all of the elements of Appellant's claimed invention, and it is respectfully requested that the rejection of Claim 1, 2, and 4 under 35 U.S.C. 102(b) be reversed. Claim 4 is directed to statutory subject matter, and it is respectfully requested that the rejection of Claim 4 under 35 U.S.C. 101 be reversed. Claim 4 is definite, and it is respectfully requested that the rejection of Claim 4 under 35 U.S.C. 112, paragraph 2, be reversed. Accordingly, it is respectfully submitted that the rejections of Claims 1, 2, and 4 are in error, and reversal thereof is respectfully requested.

Respectfully Submitted,

Dated: 21 JAN 2003  
Telephone No.: (607) 755-3284  
Fax No.: (607) 755-3250

By: William E. Schiesser  
William E. Schiesser  
Registration No. P-53,559



UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Patent Application of:

Applicant: R. F. Gloor et al. : IBM Corporation  
Serial No.: 09/439,310 : Intellectual Property Law  
Filed: 11/12/1999 : Department N50E/040-4  
: 1701 North Street  
Group Art Unit: 3621 : Endicott, New York 13760  
Examiner: James A. Reagan

Title: Business Method for Quality Assurance of Services  
Docket No.: EN999079

Assistant Commissioner for Patents  
Washington, DC 20231

**APPENDIX - CLAIMS ON APPEAL**

1. A quality assurance method for a services solution, comprising the steps of:

defining a first solution by a provider having a business objective, for a customer having a need;

performing a first assurance review of said first solution to determine whether said first solution is technically viable, deliverable, and includes technical risk identification, assessment, and containment plans;

performing a second assurance review of said first solution to determine whether said first solution includes complete schedules, a complete cost and profit case, and said first solution satisfies both said provider business objectives and said customer need;

defining a second solution by said provider, by correcting any deficiencies identified in said first or second assurance reviews;

obtaining customer commitment to said second solution;

thereafter, performing a first readiness review of said second solution to identify new issues or risks which arose during said obtaining customer commitment step, determine whether delivery plans are established, and establish baselines for performance and said profit case;

periodically performing a project management review to verify said second solution is being managed as defined, meeting said profit case, and meeting said customer need; and

thereafter, performing a deliverable readiness review to verify that said second solution has been delivered to said customer and that said second solution satisfies said customer need.

2. The method as set forth in claim 1, further comprising the step of performing a third assurance review of said second solution to determine whether said deficiencies have been satisfactorily corrected.

4. The method as set forth in claim 1, wherein said first readiness review is performed by conducting a meeting to examine whether written delivery plans comprising communication delivery plans, organization delivery plans, tracking delivery plans, change control delivery plans, quality management delivery plans, and reporting delivery plans are all established.